UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,453	07/27/2001	David J. Green	0325.00487	8728

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EXAMINER
EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
2162	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Advisory Action	09/916,453	GREEN ET AL.
	Examiner	Art Unit	
	Fred I. Ehichioya	2162	

-- Th MAILING DATE of this communication app ars on th cov r sheet with th corr spondence address --

THE REPLY FILED 17 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *1 - 20*.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). *12172004*.

10. ☐ Other: _____

SHAHID ALAM
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: The applicants arguments are not persuasive

Response to Arguments

Applicants argue:

(a)   Incomplete Office Action
Applicants' representative respectfully request that the next communication be presented in non-final form due to a lack of proper development for the present rejections. . . (viii) evidence of a reasonable expectation of success for the proposed combination used to reject claim 10 (page 7, paragraph 1).

(b)   Finality of the Office Action

b-1.   The rejection of claim 1 over co-pending Application No. 09/992,652 is respectfully traversed and should be withdrawn. The co-pending application is not an issues patent and thus the double patenting rejection is inappropriate under MPEP §804.I.A. (page 9, paragraph 1).

b-2.   Schmitz and Free, alone or in combination, do not teach or suggest steps (A) generating a programming item from a plurality of parameters that define a programmable logic device and (B) storing the programming item in a programming field of the file suitable for programming the programmable logic device and (c) storing at least one of the parameters in a non-programming field of the file as presently claimed. (page 11, paragraph 2).

b-3.   The Office Action fails to provide clear and particular motivation to combine Schmitz and Freeman. (page 13, paragraph 2).

b-4.   The references appear to be non-analogous art. (page 14, paragraph 3).

b-5.   Claim 20 further provides a structure comprising a means for generating, a first means for storing and a second means for storing. In contrast, each of Schmitz and Freeman appear to be silent regarding a structure comprising a means for generating, a first means for storing and a second means for storing. (page 15, paragraph3).

b-6.   The Office Action does not clearly identify (i) a second non-programming field within a file suitable for programming a programmable logic device and (ii) a parameter other than the error checking signal. Page 16, paragraph 2).

b-7.   Schmitz and Freeman, alone or in combination, do not teach or suggest a step of storing an identification item configured to identify a programmable logic device in a second non-programming field of a file. (page 17, paragraph 2).

b-8.   Schmitz and Freeman, alone or in combination, do not teach or suggest a step of bracketing a non-programming field of a file with a pair of delimiters. (page 18, paragraph 3).

b-9.   Nowhere in the above text, or in any other section, does Freeman appear to discuss (a) another parameter of a programmable logic devices, (b) a second non-programmable field of a file and (c) a file suitable for programming the programmable logic device. (page 19, paragraph 2).

b-10.   Schmitz, Freeman and Schultz, alone or in combination, do not appear to teach or suggest a step of storing a frequency parameter in a non-programming field of a file. (page 21, paragraph 2).

b-11.   Schmitz, Freeman and Schultz, alone or in combination, do not appear to teach or suggest a step for (i) storing at least one of plurality of parameters that define a program for a programmable logic device in a non-programming field of a file and (ii) storing a second of the parameters in a second non-programming field of the file. (page 22, paragraph 2).

Regarding argument (a): The Office Action of February 26, 2004states clearly that claims 1 - 20 were rejected by patent numbers 5,128,871; 5,396,505 and 6,255,848 by addressing individually each claim limitation. Thus, the applicants' argument are not persuasive.

Regarding argument (b-1):   Examiner respectfully disagrees with the applicants. A double patenting may exist between a published patent application and an application filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by common assignee. Since the published application has not yet issued as a patent, the examiner is permitted to make a "provisional" rejection based on the ground of double patenting. MPEP §804.I.C.

Regarding argument (b-2): The Examiner respectfully disagrees with the applicants. Examiner addressed these limitation of claim in the Final Office Action mailed September 13, 2004 by citing lines and columns of the applied references.

Regarding argument (b-3): Examiner respectfully disagrees with the applicants. MPEP §2124 requires "Exception to the rule that the critical reference date must precede the filing data" and does not   ₂have anything to do with "suggestion or motivation to modify the

references". There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. MPEP §2143.01. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 -58. Regarding page 5, of the last Office Action, the motivation fairly suggest the benefits of the invention of Freeman - "error checking signal" is used to check if configuration or protocol is changed so that the system can facilitate the reprogramming to compensate for the change (see Abstract).

Regarding argument (b-4): Examiner respectfully disagrees with the applicants. Schmitz discloses "apparatus and method for allocation of resources in programmable logic devices" (Title) and Freeman discloses "programmable error-checking matrix for digital communication system" (Title). Though these inventions are in different classifications, they are reasonably pertinent to the particular problem with which the applicants' were concerned (In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir.1992).

Regarding argument (b-5): it is respectfully noted that applicant's arguments appear incommensurate in scope with the limitations of representative claims. In particular, the examiner does not see "a means for generating, a first means for storing and a second means for storing." However, the examiner has responded to the limitation of claim 20 by citing columns and lines of the applied reference in the last Office Action.

Regarding argument (b-6): As pointed out in (b-5) the applicants are arguing the inventions that are not claimed. Again, it is respectfully noted that applicant's arguments appear incommensurate in scope with the limitations of representative claims. In particular, the examiner does not see "a second non-programming field within a file suitable for programming a programmable logic device." However, the examiner has responded to the limitation of claim 5 by citing columns and lines of the applied reference in the last Office Action.

Regarding argument (b-7): As pointed out in the last Office Action, Schmitz teaches the step of storing an identification item configured to identify said programmable logic device in a second on□programming field of said file (column 2, lines 44 - 57).

Regarding argument (b-8): As discussed regarding claims 9 and 19, Schmitz discloses bracketing non-programmable field as shown in Fig.26 and column 18, lines 26 - 31 and column 30, lines 9 - 13, "Examples of each record type are given with the syntax for that record. Brackets and ellipses ("[. . .]")" in the last Office Action.

Regarding argument (b-9): Again, it is respectfully noted that applicant's arguments appear incommensurate in scope with the limitations of representative claims. In particular, the examiner does not see "(a) another parameter of a programmable logic devices, (b) a second non-programmable field of a file and (c) a file suitable for programming the programmable logic device." However, the examiner has responded to the limitation of claim 10 by citing columns and lines of the applied reference in the last Office Action.

Regarding argument (b-10): As discussed regarding claims 2 and 12, Schultz teaches storing is storing a frequency parameter in said non□programming field (see column 20, lines 36 - 67 and column 21, lines 1 - 6) in the last Office Action.

Regarding argument (b-11): Again, it is respectfully noted that applicant's arguments appear incommensurate in scope with the limitations of representative claims. In particular, the examiner does not see "storing a second of the parameters in a second non-programming field of the file." However, the examiner has responded to the limitation of claim 3 by citing columns and lines of the applied reference in the last Office Action.

In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Office Action. For the above reasons, Examiner believed that rejection of the last Office action was proper. Therefore, the above discussed teachings of teachings of Schmitz, Freeman and Schultz clearly teaches the claimed limitations.

The IDS filed on 2/9/04, 8/23/04 and 11/17/04 are hereby acknowledged and considered.